

REMARKS

Claims 14-21 have been cancelled. Claims 1-13 are pending in the present application. Claims 22-24 has been added. Claims 1-13 stand rejected. The Examiner's reconsideration of the rejected claims is respectfully requested in view of the following remarks.

Restriction Requirement

Applicants affirm the election of claims 1-13, but still traverse the restriction requirement. Indeed, it should be noted that in hindsight, the basis for the Examiner's restriction requirement appears to be inconsistent with the Examiner's search. The Examiner's rationale for the restriction requirement was based on Group I belonging to class 220, subclass 675 and Group II belonging to class 425, subclass 256. However, in the Office Action, the Examiner cited references against claims 1-13 from classes other than 220, namely classes 206, 229, and 40. In this regard, there has been no showing that the claims of Groups I and II would be separately classified as indicated by the Examiner, and Applicants believe that said Groups are most likely commonly classifiable.

Therefore, for at least the above reasons, it is respectfully submitted that there would be no serious burden on Examiner to simultaneously examine claims of Groups I and II. Under such circumstances, it is respectfully requested that the Examiner maintain all claims in the same application.

Claim Rejections - § 103(a)

Claims 1-13 stand rejected as being unpatentable over Williams in view of Wolf and MacDaniel, as set forth on pages 3-4 of the Office Action. Applicants respectfully submit that at the very minimum, the combination of Williams, Wolf and MacDaniel is legally deficient to establish a *prima facie* case of obviousness against claims 1-13.

Claim 1 recites “*an image disposed on the outer surface of the sidewall portion, wherein the image is scratchable along any portion of the image by a user to personalize said container*”. Claim 6 recites “*wherein the image is formed such that any portion of said image is scratchable by a user to personalize the cup*”. Since none of the cited references disclose an image that is scratchable, at the very least, a scratchable image for personalization is neither anticipated nor rendered obvious by the cited references.

Accordingly, claims 1 and 6 are believed to be patentable over the combination of Williams, Wolf, and MacDaniel. Moreover, claims 2-5 are patentable over such a combination at least by virtue of their dependence from claim 1, and claims 7-13 are patentable over such a combination at least by virtue of their dependence from claim 6.

Withdrawal of the claim rejections under 35 U.S.C. § 103 is respectfully requested.

Claim 22 recites “*an image disposed on the outer surface of the sidewall portion, wherein the image is depressible along any portion of the image by a user to personalize said container*”. The Examiner’s 103(a) rejections will be addressed with reference to claim 22.

By way of example, with respect to claim 22, it is submitted that the combination of Williams, Wolf, and MacDaniel does not disclose or suggest “*an image disposed on the*

outer surface of the sidewall portion, wherein the image is depressible along any portion of the image by a user to personalize said container”.

The Examiner acknowledges on page 3 of the Office Action that Williams does not disclose “*an image disposed on the outer surface of the sidewall portion, wherein the image can be scratched, depressed, or any combination thereof, along any portion of the image by a user*”. However, the Examiner asserts that the combined teachings of Williams with Wolf and MacDaniel, renders the claimed inventions obvious with regard to an image being depressed. The Examiner states the following:

“It would have been obvious to modify the identification means of Williams by replacing the bubbles with dimples as taught by Wolf and by raised images as taught by Wolf and MacDaniel to eliminate a part, the plastic bubbles, that are no longer needed, to integrally mold the container, dimples and raised images from one-piece thus saving the time and expense of separately manufacturing bubbles and placing them on the container and to eliminate the printing of the images on the sidewall in a separate operation. The raised images on the dimples provides images that are more prominent and easily read because they project from the outer surface of the sidewall and they are not positioned beneath a bubble.”

It is well-established that hindsight reasoning based on applicants disclosure may not be used to combine references. Applicants submit that the only way to combine the teachings of Williams with Wolf and MacDaniel, as argued by the Office Action, is to use such impermissible hindsight reasoning. To begin, the Examiner cites a number of advantages as support for the motivation to combine the cited references, including saving the time and expense of adding bubbles to the container and improving the readability of the images under the bubbles. However, none of the cited references teach these advantages and such knowledge is directly gleamed from the introduction of the claimed inventions, which is one indication that the rejections are based on impermissible hindsight reasoning.

Moreover, the lack of motivation to combine Williams with Wolf and MacDaniel is further evident in that none of the references discuss personalization. The stated purpose of the dimples in Wolf (in col. 2, lines 65-67) is to indicate the contents of a container, and not to personalize the container. As an example, if two customers purchased black coffee, the set of dimples depressed on the lids of their cups would be the same, in contrary to a user personalization of the cups. In addition, Wolf teaches labeled dimples on a plastic lid of a cup (in Fig. 1) and not on the surface of the sidewall portion of a container as recited, *inter alia*, in claims 22. The stated purpose of the raised or embossed lettering in the sidewall of a container in MacDaniel (in col. 5, lines 5-8) is for advertising or decoration, and not to personalize the container. As an example, if two customers bought a container from the same manufacturer, the raised lettering would display the same manufacturer name, in contrary to user personalization of the containers. In both instances, indication of contents of the container and advertising are not the same or similar to personalization.

Accordingly, claim 22 is believed to be patentable over the combination of Williams, Wolf, and MacDaniel. Claims 23-24 are patentable over such a combination at least by virtue of their dependence from claim 22.

In view of the foregoing remarks, it is respectfully submitted that all the claims now pending in the application are in condition for allowance. Early and favorable reconsideration is respectfully requested.

Respectfully submitted,

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